

TME-2217 - Application No. 10/538,168  
Response to Office action March 26, 2010  
Response submitted May 26, 2010

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1, 4, and 20 remain in the application. Claims 2, 3, and 5-19 were previously cancelled.

In item 4 on page 2 of the above-identified Office action, claims 1 and 20 have been rejected as being obvious over Mumford (U.S. Patent No. 4,093,103) in view of Hermelin et al. (U.S. Patent No. 6,375,956) (hereinafter "Hermelin") under 35 U.S.C. § 103.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 1 calls for, *inter alia*:

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a package having a chamber formed therein, the chamber containing a suppository therein, the package having a second chamber formed therein, the second chamber being separate from the chamber and disposed within the chamber, and the second chamber containing a lubricant therein.

On pages 2-3 of the Office action the Examiner alleges that "Mumford discloses the claimed invention except for the package is a suppository package, the chamber containing a suppository, and the second chamber containing a lubricant."

The Examiner's allegation is not an accurate representation of Mumford. Specifically, the Examiner appears to ignore the fact that Mumford does not disclose that anything is disposed in the area at the Examiner alleges as the "chamber" (Examiner's "interior of package outside second chamber 53"). Furthermore, Mumford discloses that the Examiner's "chamber" has an opening in the rear wall between elements "38" and "42" (column 3, lines 8-22 and figures 1, 3, and 5). Therefore, because Mumford explicitly discloses to only store products in a sealed chamber, Mumford does not disclose disposing items in the unsealed area of the container that the Examiner considers the "chamber". Accordingly, because Mumford does not disclose to dispose objects in the unsealed area of container that the Examiner considers the "chamber", Mumford explicitly teaches

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away from disposing any items in the area that the Examiner considers as the "chamber". As such, the Examiner's above-noted allegation is not an accurate representation of Mumford.

Furthermore, on page 3 of the Office action the Examiner alleges that "it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the package of Mumford by placing a suppository in the chamber and a lubricant (cream) in the second chamber."

It is respectfully noted that the Examiner's allegation is in error. Specifically, as indicated above, Mumford does not disclose to dispose anything in the "chamber". Also, as shown above, Mumford explicitly discloses that the "chamber" is not sealed. Therefore, products disposed in the "chamber", such as a suppository (or lubricant) would be susceptible to unacceptable contamination. Accordingly, it is respectfully noted that the Examiner's allegation with respect to the modification of Mumford, is in error.

Moreover, the Examiner is reminded that in MPEP 2143 states that:

**VI. THE PROPOSED MODIFICATION CANNOT  
CHANGE THE PRINCIPLE OF OPERATION OF A  
REFERENCE**

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

As noted above, Mumford explicitly discloses to dispose products in a sealed internal chamber of a container. As seen from the above-given remarks, disposing product in the area of the container alleged by the Examiner would place product in a chamber that is not sealed. Therefore, the modification of Mumford as alleged by the Examiner would in fact change the principle of operation of the container of Mumford, as product disposed in the "chamber" of the container would not be sealed due to the opening in the container, thereby changing the principle of operation of the container of Mumford.

Accordingly, according to MPEP 2143, because the modification of Mumford as alleged by the Examiner would necessarily change the principle of operation of Mumford, the teachings of the references are not sufficient to render the claims *prima facie* obvious.

As seen from the above-given remarks, claim 1 is allowable over Mumford view of Hermelin. Since claim 1 is allowable

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over Mumford in view of Hermelin, dependent claim 20 is allowable over Mumford in view of Hermelin as well.

In item 5 on page 3 of the Office action, claim 4 has been rejected as being obvious over Mumford (U.S. Patent No. 4,093,103) in view of Hermelin (U.S. Patent No. 6,375,956) and further in view of Davidowitz (U.S. Patent No. 3,712,300) under 35 U.S.C. § 103. Davidowitz does not make up for the deficiencies of Mumford and Hermelin. Since claim 1 is allowable, dependent claim 4 is allowable as well.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1. Claim 1 is, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claim 1, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1, 4, and 20 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

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If an extension of time for this paper is required, petition  
for extension is herewith made.

Please charge any other fees which might be due with respect  
to Sections 1.16 and 1.17 to the Deposit Account of Lerner  
Greenberg Stemer LLP, No. 12-1099.

Respectfully submitted,

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